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**THIS DISPOSITION
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Paper No. 12
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gibson Guitar Corp.

Serial No. 75/591,787

Lucian Wayne Beavers of Wadley & Patterson for Gibson
Guitar Corp.

Rebecca A. Smith, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before Cissel, Wendel and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

Gibson Guitar Corp. (applicant) has applied to
register the mark LEARN2PLAY (in typed form) on the
Principal Register for services ultimately identified as
"providing on-line instruction lessons over a global
computer network for playing musical instruments, namely -
on-line one-on-one interactive lessons; and on-line group
lessons" in International Class 41.¹ The application is

¹ Serial No. 75/591,787 filed on November 10, 1998.

based on an allegation of a bona fide intention to use the mark in commerce.

The Examining Attorney has finally refused to register applicant's mark under Section 2(d) of the Trademark Act because of a prior registration for the mark THE LEARN TO PLAY STORES in typed form for "retail outlets for organs, pianos, digital pianos, portable keyboards, string instruments, band instruments, amplifiers, combo equipment, sheet music and accessories for all instruments" in International Class 42.² 15 U.S.C. § 1052(d). The cited mark is registered on the Supplemental Register, and it contains a disclaimer of the word "stores."

After the Examining Attorney made the refusal final, this appeal followed. Both applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

The Examining Attorney's position is that the marks LEARN2PLAY and THE LEARN TO PLAY STORES are highly similar and that the services are highly related. The Examining Attorney provided copies of Yellow Pages advertisements that showed that music stores similar to the registrant's also provide music instructions. Therefore, potential customers seeking music instruction services "would

² Registration No. 1,996,299, issued August 20, 1996.

mistakenly believe that the services of the applicant and the registrant emanated from the same source." Examining Attorney's Br. at 8.

Applicant, on the other hand, points to the differences between its mark and the registered mark. It notes that it spells its mark as a single word; that registrant uses the number "2," while registrant uses the word "to"; and that registrant's mark adds the words "the" and "stores" to its mark. These differences, applicant asserts, lead to a different commercial impression. Regarding applicant's and registrant's services, applicant argues that "it is unreasonable to believe that the Registrant, which currently does not render any instructional classes, can be expected to bridge the gap and provide those instructional lessons over the Internet." Applicant's Appeal Br. at 4. Applicant also asserts that the services would be purchased "under different conditions and circumstances by individuals who fall within the category of discriminating purchasers who normally buy with care after an assessment of all options." Id.

After a review of the record and the arguments of the applicant and the Examining Attorney, we conclude that confusion would be likely if applicant's and registrant's

marks were used on the respective services in the application and registration.

Determining whether there is a likelihood of confusion requires consideration of the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In evaluating the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin our analysis by comparing the marks in the registration and the application. We agree with applicant that there are differences in the marks, but we are not persuaded that these differences result in different commercial impressions. The marks are similar, if not virtually identical, in sound, appearance, and meaning. Both marks would be pronounced identically with the only differences being that applicant adds the definite article "the" and the generic word "stores." While we must consider marks in their entirety, disclaimed matter is often given less weight than other elements of a mark. An applicant's addition of the words "The" and "Cafe" and a

diamond-shaped design to registrant's DELTA mark still resulted in a likelihood of confusion. In re Dixie Restaurants, 105 F.3d 1405, 1406, 41 USPQ 1531, 1534 (Fed. Cir. 1997) (more weight given to common dominant word DELTA). Similarly here, the addition of the definite article and the generic word "stores" does not overcome the similarities in the marks.

Also, while registrant separates the words in its mark with spaces and applicant compresses the words, this does not create a different commercial impression. Nor does applicant's use of the number "2" instead of the word "to" change the fact that when potential customers encounter the marks they would have similar appearances. It would be readily discernable that the dominant part of the marks would be the common terminology "learn to (or 2) play). The use of a phonetic equivalent with a slight misspelling does not result in a term with a markedly different appearance from a registered mark. In re Research and Trading Corp., 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) ("There is little room to debate the similarity between ROPELOCK and ROPELOK in appearance").

While we find that the marks are similar in appearance, they are virtually identical in sound and meaning. Both marks would be pronounced the same except

for the addition words "the" and "stores" in the registered mark. Their meanings and commercial impressions would likewise be virtually identical, i.e., a place where people can learn to play musical instruments.

We now look at the services to see if they are similar. Applicant seeks registration for services described as providing on-line instruction lessons over a global computer network for playing musical instruments, namely, on-line one-on-one interactive lessons; and on-line group lessons. The cited mark is registered for retail outlets for organs, pianos, digital pianos, portable keyboards, string instruments, band instruments, amplifiers, combo equipment, sheet music and accessories for all instruments. To determine whether the services are related, we must look to the identification of the services in the application and registration. Dixie Restaurants, 41 USPQ2d at 1534; Canadian Imperial Bank of Commerce v. Wells Fargo Bank, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

The issue is whether the services of offering instrument lessons over the Internet are related to retail store services featuring musical instruments, sheet music, and accessories. It is not necessary that the respective

services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the services are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association or connection between the producers of the respective goods or services. See In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991); In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978).

The Examining Attorney has submitted evidence consisting of pages from a local Yellow Pages directory that show that stores both sell musical instruments and provide musical instruction.

Springfield Music Center - "Instruction - Sales - Repairs"

CMC Contemporary Music Center - "Instruments Accessories Instructions Rentals"

Chantilly Musical Instruments - "Rentals - Repairs - Lessons - Sheet Music"

Melodee Music - "Guitars - Amps - Pianos - Books - Instructions"

Capone Music Co., Inc. - "Top Quality Musical Instruments ... Professional School of Music"

Old Towne Music - "Instruments ... Accessories - Music - Lessons"

The Guitar Shop - "Sales - Instruction - Repairs"

Music & Arts Center - "Guitars, Keyboards, Lessons, Music, Accessories & More"

Music stores often have Internet sites: Capone Music Co., Inc. (www.dcmusicnet.com/capone); Chuck Levin's Washington Music Center (www.wmcworld.com); and Action Music (www.actionguitar.com). Based on this evidence, it would not be unexpected that a music store would also be associated with online instrument lessons. This is particularly true for a music store named THE LEARN TO PLAY STORE, which is admittedly a descriptive term when applied to these services. We find that the evidence supports the Examining Attorney's conclusion that the services of selling musical instruments and providing on-line music instruction are highly related. When purchasers of registrant's services encounter applicant's mark used for its services, they are likely to believe that there is an association between the sources of the services.

Applicant argues that the cited mark, which is registered on the Supplemental Register, is merely descriptive of such services and as such, "is entitled to a

very narrow scope of protection." Applicant's Appeal Br. at 6. Marks that are descriptive of the goods or services are registrable on the Supplemental Register. However, it has long been held that "a mark registered in the Supplemental Register can be used as a basis for refusing registration to another mark under §2(d) of the Act." In re The Clorox Co., 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978).

The Federal Circuit has clearly rejected the argument that marks registered on the Supplemental Register are entitled to almost no scope of protection. "It is thus not necessary that the goods of the parties be identical in order to sustain a finding of likelihood of confusion." Research and Trading Corp., 230 USPQ at 50 (ROPELOK for safety fall protection equipment for attachment to workers operating at elevated heights, said equipment comprising a lifeline engaging element actuated by a fall and a shock-absorber sold as a unit confusingly similar to ROPELOCK registered on the Supplemental Register for releasable locking buckles for ropes particularly for industrial purposes").

The standard set out in Clorox is flexible.

Appellant next posits a requirement that citation of marks on the Supplemental Register under §2(d) be limited to marks identical to that sought to be

registered. No reason exists, however, for the application of different standards to registrations cited under §2(d). The level of descriptiveness of a cited mark may influence the conclusion that confusion is likely or unlikely, see *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 45 CCPA 856, 859, 254 F.2d 158, 160, 117 USPQ 295, 297 (1958), but that fact does not preclude citation under §2(d) of marks on the Supplemental Register.

Clorox, 198 USPQ at 341.

Applicant also argues that "Applicant's and Registrant's services would be purchased as a result of different motivations and under different conditions and circumstances by individuals who fall within the category of discriminating purchasers who normally buy after an assessment of all options." Applicant's Br. at 4. The Yellow Pages advertisements apparently are directed to a wide cross-section of purchasers. See Twinbrook Music ad ("Music Instructions by outstanding instructors: beginning, advanced, children, adults"); Capone Music ad ((Excellent School Rental/Purchase Plan); Music & Arts Center ad ("Band and orchestra rentals, guitars, keyboards, lessons"). While instruments and instructions may be purchased by different purchasers who may be highly sophisticated, there is evidence in the record that supports the Examining Attorney's conclusion that the purchasers of instruments and instructions would overlap and that potential purchasers would include novices and

parents purchasing and renting instruments and obtaining lessons for their children to learn how to play musical instruments. Moreover, even sophisticated purchasers would likely be confused if similar services were marketed under highly similar marks such as applicant's and registrant's. Octocom Systems Inc. v. Houston Computer Services, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

While we have taken into consideration the fact that the cited mark is registered on the Supplemental Register and it is descriptive of the recited services, when this is balanced against the close similarity of the marks and the relatedness of applicant's and registrant's services, we conclude that confusion would be likely if applicant were to use the mark it seeks to register in connection with the services specified in the application.

Decision: The refusal to register is affirmed.